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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/082,309	05/20/1998	ANDREAS WALDER	15258-176-1U	2544

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EXAMINER

STAICOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/08/2002

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 17

Application Number: 09/082,309  
Filing Date: May 20, 1998  
Appellant(s): Andreas Walder

\_\_\_\_\_  
Kevin T. LeMond  
For Appellant

**MAILED**

FEB 08 2002

**GROUP 1700**

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed January 18, 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. No amendment after final has been filed. A request for reconsideration was filed on June 18, 2001 subsequent to the Final Office Action mailed December 19, 2000.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 16-26 and 28-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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3,751,377	BUCKNER	08-1971
3,372,215	MUIRHEAD et al.	03-1968
4,314,606	MULLER et al.	02-1982

**(10) *New Prior Art***

No new prior art has been applied in this Examiner's Answer.

**(11) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

(1) Claims 16-26 and 28-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) In claim 16, line 1, the limitation "which does not use extruders" does not appear to be supported by the original disclosure. Specifically, on page 5, lines 25-27, the original disclosure describes a method for the production of expandable plastics granulate including "a heatable extruder...used as a melting device". Claims 17-26 and 28-29 are rejected as dependent claims.

(b) The rejection of claims 16-26 and 28-29 under 35 U.S.C. 112, first paragraph, regarding the newly added limitation in claim 16, lines 15-17, of "wherein the dispensing of the blowing agent and the retaining of the mixture is carried out in a single apparatus" has been withdrawn upon further consideration and in view of Appellant's remarks.

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(2) The rejection of claims 16-17, 19-23, 25 and 28 under 35 U.S.C. 103 as obvious in view of Buckner (US Patent No. 3,751,377) in view of Muirhead *et al.* (US Patent No. 3,372,215) has been withdrawn. The reasons for withdrawal are explained in detail in subsection (13) below.

(3) The rejection of claims 18 and 29 under 35 U.S.C. 103 as obvious in view of Buckner (US Patent No. 3,751,377) in view of Muirhead *et al.* (US Patent No. 3,372,215) and in further view of Muller *et al.* (US Patent No. 4,314,606) has been withdrawn. The reasons for withdrawal are explained in detail in subsection (13) below.

**(12) *New Grounds of Rejection***

No new grounds of rejection have been applied in this Examiner's Answer.

**(13) *Response to Argument***

Appellant argues that the original disclosure does have support for a process "being carried out without the use of extruders" (see pages 9 and 10 of the Appeal Brief filed January 18, 2002). However, as shown throughout prosecution of the instant application, the original disclosure describes a process for the production of expandable plastics granulate including "a heatable extruder...used as a melting device" (see page 5, lines 25-27). Further, it should be noted that on page 6, lines 5-6, the original disclosure specifically describes that "During the granulation step...the mixture is *extruded* through nozzles while the pressure drops" (emphasis added). Hence, it is submitted that if the mixture is "extruded", then the process requires the use of an "extruder" in order for the mixture to be "extruded" as described. Therefore, the original disclosure does not have support for a process "being carried out without the use of extruders."

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Appellants argue that Buckner ('377) teaches "using an extruder 31" and that Muirhead *et al.* ('215) "teach using an extruder 10" (see page 11 of the Appeal Brief filed January 18, 2002. As shown above, the rejections based on the teachings of Buckner ('377) and Muirhead *et al.* ('215) have been withdrawn. The reasons for withdrawal are as follows:

(a) Although Buckner ('377) teaches "using an extruder 31", it should be noted that extruder "31" in the teachings of Buckner ('377) is used *only* as a melting device (see Figure 2) (emphasis added). Further, it should be noted that Appellant states on page 10, lines 1-2, of the Appeal Brief filed January 18, 2002, that in the instant application "the heateable extruder is disclosed as being used as a melting device and this is not [the] subject matter of the claimed method." Therefore, in view of Appellant's statement, the process of Bruckner ('377) coincides on this point with that process argued by Appellant as the subject matter of Appellant's claimed method.

However, Bruckner ('377) teaches the use of an extrusion die (19, 35) (see col.3, line 60 and col. 4, lines 59-61). Therefore, since an "extrusion die" is used to "extrude" the plastic material, it is submitted that the process of Bruckner ('377) is performed using an extruder and as such the rejection under 35 U.S.C. 103 of claims 16-26, 28 and 29 was withdrawn.

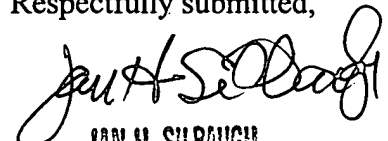
(b) Muirhead *et al.* ('215) teach a process of granulating an extruded stream of expandable polymer. Hence, the process of Muirhead *et al.* ('215) is performed using an extruder and as such, the rejection under 35 U.S.C. 103 of claims 16-26, 28 and 29 was withdrawn.

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However, it is again noted that on page 6, lines 5-6, the original disclosure specifically describes that "During the granulation step, interval IV, the mixture is *extruded* through nozzles while the pressure drops" (emphasis added). Bruckner ('377) teaches the use of an extrusion die (19) to shape the resulting body (20) (see col.3, lines 60-63), whereas Muirhead *et al.* ('215) teach a process of granulating an extruded stream of expandable polymer. It would appear that both references teach a step of extrusion during the last phase of the process which coincides with that operation described at page 6, lines 5-6, of the Appellant's original disclosure.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINEE  
ART UNIT 1732

02/07/02

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February 7, 2002

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